



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,787	06/13/2006	Masato Kaneda	Q79148	5976
23373 7590 11/25/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
BOFF, ANCA				
ART UNIT		PAPER NUMBER		
1795				
NOTIFICATION DATE		DELIVERY MODE		
11/25/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com  
PPROCESSING@SUGHRUE.COM  
USPTO@SUGHRUE.COM

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/582,787

**Applicant(s)**

KANEDA ET AL.

**Examiner**

ANCA EOOF

**Art Unit**

1795

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 November 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 3, 6, 12, 14, 16 and 18.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s): 11/10/2009  
13. ☐ Other: \_\_\_\_\_.

/Cynthia H Kelly/  
Supervisory Patent Examiner, Art Unit 1795

/Anca Eoff/  
Examiner, Art Unit 1795

Continuation of 11, does NOT place the application in condition for allowance because: On pages 4-5 of the Remarks, the applicant argues the rejection of claims 3, 12-14, 16 and 17 under 35 USC 103(a) over Koyanagi et al. (WO 03/072634, wherein the citations are from the English equivalent US Pg-Pub 2005/0153530) in view of Wyatt et al. (US Pg-Pub 2003/0118946). The applicant argues that based on the examples of Wyatt, one of ordinary skill in the art would not have been motivated to use tetramethylbenzene in an amount of 20% by mass in the developer of Koyanagi.

The examiner would like to show that Koyanagi et al. teach the use of tetramethylbenzene in a developer for photosensitive composition (par.0123) and tetramethylbenzene is an aromatic hydrocarbon.

Wyatt et al. teach developer for photosensitive printing plates, wherein said developer may comprise 20% by mass of an aromatic hydrocarbon (see Example 4 in table 1, par.0062). Therefore, one of ordinary skill in the art would have been motivated to apply the teaching of Wyatt and use an aromatic hydrocarbon in an amount of 20% by mass in a developer composition, with a reasonable expectation of success.

On page 5 of the Remarks, the applicant argues that Koyanagi et al. and Wyatt et al. teach developers and do not teach the removal of a photosensitive composition containing a pigment. The examiner would like to note that the limitation of claim 3 "wherein the photosensitive composition remover is used for removal of a photosensitive composition containing a pigment" is merely an intended use and adds no patentable weight to the claim.

The examiner would also like to point out that Koyanagi et al. teach that the developer dissolves/removes the unexposed areas of the photosensitive composition (par.0171) so it is a remover.

On page 6 of the Remarks, the applicant argues the rejection of claims 3, 16 and 17 under 35 USC 103(a) over Kamayachi et al. (US patent 4,943,516) in view of Wyatt et al. (US Pg-Pub 2003/0118946).

The applicant argues that the developers of Kamayachi et al. are quite different than the remover of the present application and that Kamayachi et al. do not relate to a remover for a photosensitive composition containing a pigment.

The examiner would like to show that Kamayachi et al. show that the unexposed portions of the photosensitive composition are developed with the developer solution (column 16, lines 15-17) so the developer of Kamayachi et al. works as remover. The composition of the remover of the instant application is obvious over the combination of Kamayachi and Wyatt, as shown in paragraph 5 of the Final Rejection. In view of the response to the arguments, the rejection of records for the pending claims are maintained.